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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Joan C. Teng

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03/27/2008

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EXAMINER

RUTLEDGE, AMELIA L

ART UNIT

PAPER NUMBER

2176

MAIL DATE

DELIVERY MODE

03/27/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 09/998,895	Applicant(s) TENG ET AL.
Examiner AMELIA RUTLEDGE	Art Unit 2176

--THE MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 March 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☒ Other: See Continuation Sheet.

/Doug Hutton/
Supervisory Patent Examiner
Technology Center 2100

Continuation of 11, does NOT place the application in condition for allowance because:

Applicants' arguments filed 03/18/2008 have been fully considered but they are not persuasive.

In response to applicants' arguments regarding the rejection of claims 1-3, 5, 6, 9-11, 13-16, 20, 21, 23-26, 30, 31, 33-36, and 39-46 under 35 U.S.C. 103(a) as being unpatentable over Cheng in view of McNally, regarding applicant's argument that there is no suggestion to combine the references (See Remarks, p. 11), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the suggestion to combine the references can be found within the references themselves, as cited in the claim rejections: Both Cheng and McNally are directed to the assignment of workflows and rules to users. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the intuitive interface disclosed by McNally to the workflow and organization modeling system disclosed by Cheng, since McNally and Cheng recognized the need to limit access to proprietary workflow processes (McNally col. 2, l. 33-51) while facilitating collaboration between organizations (Cheng, col. 3, l. 1-12).

Applicants argue that neither Cheng nor McNally teach the limitations recited in the independent claims of the claimed invention, (performing a workflow associated with a target identity profile including reporting a plurality of workflows to a user via a Graphical User Interface (GUI) and receiving from the user via the GUI a selection of a workflow from the plurality of workflows.) However, as set forth in the rejection of claim 1 in the office action mailed 01/09/2008: Cheng teaches that the user may use a graphical user interface to manipulate the organizational objects and tasks (col. 11, l. 52-58; col. 12, l. 64-col. 13, l. 33; Fig. 9, 10), which suggests use of a GUI to assign workflows. Cheng teaches that the organizational model of the system can be applied in workflow systems, by using the roles to assign tasks in a workflow system (col. 13, l. 9-col. 16, l. 10; col. 16, l. 10-65). However, Cheng does not explicitly teach that the GUI reports a set plurality of workflows to perform a task to the user and receives a selection of the workflow from the user. McNally is relied upon to teach a workflow distribution process with a GUI from which a user can select from a plurality of assigned workflows and perform steps of the workflow (col. 5, l. 61-col. 6, l. 59; Figs. 5-8). Therefore the combination of Cheng and McNally does disclose the limitations of the claims.

In *KSR*, the Supreme Court particularly emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious. *KSR International Co. v. Teleflex Inc.* (KSR), 82 USPQ2d 1385 (2007); MPEP 2141. The Supreme Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." 82 USPQ2d at 1395. When considering obviousness of a combination of known elements, the operative question is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." 82 USPQ2d at 1396.

In the instant application, applicants' arguments regarding the claimed invention are directed to the portion of the claims reciting assigning workflows to user groups in an identity system and allowing the user to select a workflow from a plurality of workflows using a GUI (See Remarks, p. 13, par. 2- p. 14, par. 2). The combination of Cheng and McNally discloses the claimed elements, for example; workflows, user groups, identity system, and GUI for receiving selection of workflows, thereby establishing that the claimed elements and methods were known and familiar at the time of the invention. Next, in considering the question of "whether the improvement is more than the predictable use of prior art elements according to their established functions." 82 USPQ2d at 1396, it must be determined whether reporting a plurality of workflows to a user via a Graphical User Interface (GUI) and receiving from the user via the GUI a selection of a workflow from the plurality of workflows, was a non-obvious improvement over the prior art. In the examiner's opinion, the GUI for workflow selection would have been a predictable and obvious use, since use of a GUI was suggested by Cheng, and since GUIs were widely used in the art for user selection from a list of items, such as the list of available workflows disclosed by McNally.

For these reasons, it is the examiner's opinion that the rejections should be maintained.

Continuation of 13. Other:

The information disclosure statement filed 03/18/2008 lists various official communications including USPTO Office Actions, on page 1 of the IDS. The prior art references listed in the IDS have been considered, however, the official communications have been lined through and will not be listed on the face of any patent issued. Official communications are not published prior art and should not be listed on the information disclosure statement, however it would be proper to list the references which were cited in the official communications.